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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,338

Applicant(s)

DEACON ET AL. *cd*

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 18-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 18-25 the phrase "traction means" is considered to be new matter because it was introduced into the application subsequent to the filing of the application. A means plus function recitation is construed to cover the corresponding structure, material or acts described in a specification and equivalents thereof. Addressing the particular facts of the present case, appellants only disclosed "ribs", with no mention whatsoever of any alternatives or equivalents thereof at the time of the filing of the application. Thus, one skilled in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. In this case by introducing a means plus function recitation into the present application, subsequent to its filing date (the filing date of the original parent application), appellants have, in effect, added to the original disclosure equivalents of the ribs. Thus, this late introduction of a means plus function recitation adds new matter (equivalents) to the application since the means plus

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function recitation lacks a descriptive basis as to the inclusion of any equivalents in the original disclosure.

3. Claims 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 18-25 the phrase "traction means" is vague and indefinite. The disclosed ribs are readily found to be the corresponding structure described in the specification (sixth paragraph of 35 USC 112) but the "equivalents" of the ribs in this art, as ribs are defined by appellants, are not characterized. For this reason the metes and bounds of the claims are uncertain or indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 18-20, 22, 26-30, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan, Jr. (3583082).

Jordan, Jr. shows a tract shoe cleat that may be used on synthetic turf. Jordan, Jr. seeks to overcome a damage problem that accrues from the use of long and sharp metal traction spikes that penetrate a track surface (column 1, lines 21-40). A cleat is disclosed that comprises a disc-shaped body having a plurality of bristles downwardly extending therefrom (column 1, lines 68-70). The bristles can reasonably be viewed as

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protrusions. These bristles are indicated to have sufficient stiffness so that they won't collapse or break when supporting the weight of an athlete (column 2, lines 25-27). Jordan, Jr. sets a lower limit of about 10 bristles per square inch (column 2, lines 41-42). Further, Jordan, Jr. states "in use, the bristle spikes are most effective when they result in indentation of the running surface as opposed to penetration of the surface" (column 2, lines 51-53). It is for the latter reason that "the ends of the bristles need not be pointed" (column 2, lines 53-54). Claims 3 and 9 of Jordan, Jr. reveal a length of between about 1/16 inch and ¼ inch for the bristles. Considering the disclosed density of about 10 bristles per inch it is clear that one skilled in the art would understand that the underside of the circular disc (flange) would be exposed between bristles and would also be capable of distributing weight over turf being walked on, while the bristles additionally support weight and provide traction. Based upon the overall Jordan, Jr. teachings, it is quite apparent that one skilled in the art would have fairly expected the bristles (protrusions) of Jordan, Jr. to provide traction without doing damage to the turf surface being walked on and without puncturing turf.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan, Jr..

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Jordan, Jr. discloses the claimed invention except for the exact material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polyether block urethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan, Jr. in view of Zaleski (2491596).

Jordan, Jr. shows a cleat substantially as claimed except for the exact shape of the flange. Zaleski teaches making a flange (figure 4) portion of a cleat with a concave upper surface and a convex lower surface as an alternative to a planar shaped flange (see figure 1). It would have been obvious to make the flange shaped as taught by Zaleski in the cleat of Jordan, Jr. to make the cleat press more securely to the sole and to prevent dirt and debris from collecting under the flange.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 18-34 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,354,021 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim cleats having a flange, attachments means, and traction means which provide traction without damaging turf.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

11. Claims 18-34 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No. 5,259,129 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both claim cleats having a flange, attachments means, and traction means which provide traction without damaging turf.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See MPEP § 804.

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Response to Arguments

12. Applicant's arguments filed 8/19/02 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the 112 first and second paragraph rejections, the specification as originally filed did not state "traction means such as ribs" or any other statement that provides basis for there being other or could be other structures that are equivalent to the ribs that would perform the desired functions recited throughout the specification, therefore entry of the phrase and subject matter of "traction means" after the original filing date does attempt to enter New Matter. There is no disclosure as to what structures would be equivalents, therefore it is not clear what structural limitations applicant intends to encompass with such language. Since there is no guidance as to what elements would be considered to be equivalents and applicant even argues that structures the Examiner would consider to be equivalents are not, the Examiner is at a loss as to what structures would be considered to be equivalents. The Examiner has applied a 112 second paragraph rejection because in view of applicants' arguments that the structures which the Examiner considers to be "traction means" are not "traction means", i.e. equivalents to the ribs disclosed, the Examiner is not able to determine the clear meaning and bounds of the claims and therefore the claim language is considered to be vague and indefinite because the structures which applicant intends to encompass with the language is not able to be determined. The Examiner has applied art to the claims which contain the new matter and vague and indefinite phrases as a courtesy to applicant to provide a full

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and complete office action. The Examiner has examined the claim language, which includes vague and indefinite phrases, to the best of her ability inasmuch as the claims are understood by the Examiner. It is true that applicant may broaden and use mean plus function language, this does not mean that applicant may after filing enter additional subject matter. There was no mention whatsoever of any alternatives or equivalents thereof at the time of the filing of the application, thus one skilled in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. There is no disclosure or guidance as to what equivalents would be or how to determine such. A specification must set forth an adequate disclosure showing what is meant by means-plus-function language in a claim (See *In re Donaldson*, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)) The Examiner does not have a clear understanding of what applicant considers to be an equivalent to the ribs disclosed and therefore there is no basis in the specification for this language and the language is vague and indefinite.

The examiner has reviewed the case law cited by applicant, but finds the decisions and opinions expressed therein to be non-persuasive as to the subject matter and issues of this specific application. The question of New Matter and indefiniteness is so closely tied to the facts of each particular case, that prior decisions in cases involving different facts and specification are ordinarily of little value in reaching a decision.

In response to applicants' arguments directed towards Jordan, Jr., the flange of the cleat shown and disclosed by Jordan, Jr. is clearly capable of bearing weight inasmuch

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as applicant has defined such in the specification and claims. It would appear that the elements which bear weight would depend on the surface which is being walked on, i.e. on sand it would appear that the entire bottom surface of the cleat, including the flange and protrusions would contact the sand and be weight bearing to some degree.

In response to Applicant's arguments that Jordan Jr. is not intended to be used, i.e. has not been disclosed as being used, for golfing, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). The cleat of Jordan is clearly capable of being used on turf or for golfing.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728